



JUN 3 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

PIPER MARBURY RUDNICK & WOLFE LLP
STEVEN B KELBER
1200 NINETEENTH STREET, NW
WASHINGTON DC 20036-2412

#23

In re Application of :
Kevin P. Baker et al :
Serial No.: 09/236,939 : PETITION DECISION
Filed: January 25, 1999 :
Attorney Docket No.: 9491-018-27X :

This is in response to applicants' petition under 37 CFR 1.181, filed March 28, 2002, requesting withdrawal of finality of an Office action.

A review of the file history shows that this application was filed January 25, 1999, and was amended in response to a first Office action to present claims 31-44 (Paper No. 8). The examiner mailed a non-Final Office action to applicants on June 27, 2000, and remailed the action on December 27, 2000, rejecting all claims under 35 U.S.C. 101 for lack of a specific or substantial disclosed utility and under 35 U.S.C. 112, first paragraph, for the same reason. All claims were further rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for reasons specified and under 35 U.S.C. 102(a) as anticipated by Johnson et al. The previously submitted applicants' declaration under 37 CFR 1.131 was dismissed as failing to show a practical utility.

Applicants replied on June 27, 2001, amending some claims in response to the 35 U.S.C. 112, second paragraph rejection and arguing extensively the rejections under 35 U.S.C. 101, 35 U.S.C. 112, first paragraph, and 35 U.S.C. 102(a). Incorporation of the previously submitted affidavit under 37 CFR 1.131 into the arguments was made to support applicants' position. The examiner mailed a Final Office action to applicants on September 13, 2001, in which the rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, were repeated and applicants' arguments answered. The rejection under 35 U.S.C. 102(a) over Johnson et al was also repeated and new rejections under 35 U.S.C. 102(a) over DiMardo (sic - DiMarco) et al (no explanation given) and under 35 U.S.C. 102(b) over Klein et al were made and the action was made Final.

Applicants replied with an argument after Final rejection on December 21, 2001, presenting essentially the same arguments in response to the 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, rejections in abbreviated form and supporting them by copies of two court decisions. Applicants argue the rejections under 35 U.S.C. 102(a) (both) as improper and overcome by the previously submitted declaration under 37 CFR 1.131. Applicants also presented arguments with respect to the 35 U.S.C. 102(b) rejection as not teaching the claimed invention and therefor, not anticipatory. The examiner mailed an Advisory action to applicants on January 15, 2002, noting

the request for reconsideration but not accepting it and noting only that "the arguments presented therein should be presented in response to the first instance that a rejection has been made, not after final, wherein such arguments are limited solely to those issues newly raised in the final rejection."

Applicants then filed a CPA request with the same argument as presented in response to the Final rejection. The examiner mailed a new Final Office action to applicants on March 7, 2002, setting forth the same rejection under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, for lack of utility and responding to applicants' arguments. The rejection under 35 U.S.C. 102(a) over Johnson et al and over DiMarco et al were repeated as was the rejection under 35 U.S.C. 102(b)-over Klein et al from the previous Office action. This petition followed asserting that the examiner could not make a rejection Final in a first Office action following the filing of a CPA in view of the examiner's comments in the Advisory Action.

DISCUSSION

As noted above, each Office action since the remailed Office action of December 27, 2000, has set forth a rejection under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, for lack of utility. The merits of this rejection have been argued by both the examiner and applicants, each maintaining their respective positions. In addition, the rejection under 35 U.S.C. 102(a) over Johnson et al has been set forth in each Office action and applicants have presented affidavit evidence under 37 CFR 1.131 to remove this reference; however the examiner has not accepted the affidavit for reasons set forth which are related to the lack of utility rejection of record. The positions of the examiner and applicants with respect to these rejections appears to have been fully developed. In the Final Office action two new grounds of rejection were presented with rejections under 35 U.S.C. 102(a) over DiMarco et al and 35 U.S.C. 102(b) over Klein et al. The first opportunity applicants had to argue these rejections was in the amendment submitted in response to the Final rejection. The examiner permitted the argument after Final rejection to be entered, but indicated that the arguments did not overcome the rejections of record. The examiner's comment in the Advisory action, quoted above, is not understood as it appears that no new arguments were presented or positions taken in the reply with respect to the rejections previously of record other than the possible citation and copies of two court decision relating to lack of utility. The statement, contrary to applicants' interpretation, does not indicate that full consideration of applicants' arguments was not made, only that some arguments may have been more appropriately presented in an earlier response. Obviously applicants were required to reply to any newly set forth grounds of rejection which they did in a proper manner. Thus any new arguments appear to be directed only to the new grounds of rejection. There was no indication in the Advisory action that the arguments presented were not considered or required further consideration or search. Thus applicants' argument based on M.P.E.P. 706.07(b) is not supported by the record. Applicants further argue that their arguments were not addressed in the Advisory Action and only first addressed in first Office action after filing of the CPA request which was made Final. There is no requirement that the examiner prepare extensive remarks with respect to arguments, either new or previously of record and repeated, in an Advisory Action, only that the status the rejections of the claims be indicated. Obviously brief remarks should be made to assist applicants in making a reasoned judgement as to whether to pursue further prosecution of the application or not. The remarks made, while not completely clear, are

sufficient to inform applicants that the arguments presented are insufficient to persuade the examiner of the patentability of the claims of record in the application. No effort was made to amend the claims in filing the CPA and, apparently, no contact was made with the examiner to more fully understand the remarks in the Advisory Action prior to filing the CPA request. Applicants aver that the Office action directs applicants towards making extensive changes in the record which would better be made prior to Final rejection. A review of the examiner's action fails to reveal any suggestions for changes. The examiner's judgement in making the Office action mailed March 7, 2002, a Final Office action appears to be within the guidelines set forth in the M.P.E.P.

DECISION

Applicants' petition is **DENIED**. The Finality of the last Office action, mailed March 7, 2002, is maintained.

Applicants remain under obligation to reply to the last Office action within the time period set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

Any request for reconsideration of this decision must be made within TWO MONTHS of the mailing date of this decision and should be addressed to the Office of Petitions.



Bruce M. Kisliuk
Director, Technology Center 1600